

REMARKS/ARGUMENTS

Upon entry of the present amendment, claims 17, 19-20, 23-24, 27-28, 30, and 33 will have been amended, with claims 17-35 remaining pending for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has objected to claims 19, 23, and 27, as being dependent upon a rejected base claim, but has indicated the allowability thereof if amended into independent form. By the present amendment, Applicant has rewritten these claims in independent form including all of the limitations their respective base claims. Thus, Applicant respectfully requests the allowance of these claims.

The Examiner has rejected claims 17-18, 24-25-, 28-29, and 33-34 under 35 U.S.C. § 102 (e), as being anticipated by FREEMAN (U.S. Patent No. 6,020,980). The Examiner has also rejected claims 20 and 30 under 35 U.S.C. § 103 (a), as being unpatentable over MORI (U.S. Patent No. 6,020,980), and further at a telephone discussion between the Examiner and Applicant's representative ,

attorney William BOSHНИCK, the Examiner also indicated that dependent claims 21, 22, 26, 31 and 32, were rejected under 35 U.S.C § 103 (a).

As noted above, Applicant has amended claims 17, 19-20, 23-24, 27-28, 30 and 33. In view of the herein-contained amendments and remarks, Applicant respectfully traverses the above rejection, based on the pending claims and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow.

Applicant's independent claim 17 generally relates to an image communication apparatus which has a receiver configured to receive image data from a transmitting facsimile apparatus via public switched phone network, and has a printer configured to print the received image data. The claimed image communication apparatus further has a controller which converts the received image data to data for Internet transmission, attaches the converted data to an e-mail, and transmits the e-mail to a management center. The claimed management center manages information that the image communication apparatus receives and further is configured to connect to the image communication apparatus via the Internet. The transmitted e-mail corresponds to the printed image data. Claim 28 generally recites a related method.

Applicant's independent claim 24 generally relates to an image communication apparatus which has a facsimile transmitter configured to transmit image data to a destination based on a facsimile protocol. The claimed image

communication apparatus further has an e-mail transmitter which converts the image data to data for Internet transmission, attaches the converted data to an e-mail, and transmits the e-mail to a management center. The claimed management center manages image data that is transmitted by the facsimile transmitter and further is configured to connect to the image communication apparatus via the Internet. The claimed e-mail transmitted by the e-mail transmitter corresponds to the image data transmitted by the facsimile transmitter. Claim 33 generally recites a related method.

With respect to the Examiner's rejection under 35 U.S.C § 102 (e), FREEMAN, to the contrary, relates to a system and a method in which the facsimile server device 120 receives facsimile transmissions, reforms the facsimile transmissions into computer file formats selected by a subscriber, and sends the reformed files to the e-mail system 130. FREEMAN merely discloses a facsimile server device 120 which reformats the received facsimile transmissions into computer file formats, and sends the reformatted files to the e-mail system 130. FREEMAN neither teaches nor suggests that the facsimile server device 120 has a printer configured to print the received facsimile transmission and further transmits the e-mail corresponding to the printed facsimile transmission to the e-mail system 130. Thus, FREEMAN does not disclose the image communication apparatus which prints received image data and transmits, to the claimed management center,

an e-mail corresponding to the printed image data, as substantially claimed in Applicant's independent claims 17 and 28.

Therefore, it is respectfully submitted that the features recited in Applicant's independent claims 17 and 28 are not disclosed in FREEMAN, and it is requested that the Examiner withdraw the rejection of these claims, as well as the claims dependent therefrom.

As explained above, FREEMAN merely teaches a facsimile server device 120 which reformats the received facsimile transmissions into computer file formats, and sends the reformatted files to the e-mail system 130. Thus, FREEMAN does not disclose transmitting image data to a destination, based on a facsimile protocol, and further transmitting, to a management center, an e-mail corresponding to the image data transmitted based on the facsimile protocol. Therefore, FREEMAN does not disclose the image communication apparatus which transmits image data to a destination based on a facsimile protocol and transmits, to the claimed management center, an e-mail corresponding to the image data transmitted by the facsimile transmitter, as substantially claimed in Applicant's independent claims 24 and 33.

Therefore, it is respectfully submitted that at least the features recited in Applicant's independent claims 24 and 33 are not disclosed in FREEMAN, and it is requested that the Examiner withdraw the rejection of these claims, as well as the claims dependent therefrom.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation can not be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claims 17, 24, 28, and 33 and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102.

With respect to the Examiner's rejection under 35 U.S.C. § 103 (a), Applicant's independent claim 20 generally relates to an image communication apparatus which has a scanner configured to scan image data and a panel configured to input an address of a destination. The claimed image communication apparatus has a controller which converts the received image data to data for Internet transmission, attaches the converted data to an e-mail, and transmits the e-mail to the destination input by the panel and to a management center. The claimed management center manages information that the image communication apparatus transmits to the destination and further is configured to connect to the image communication apparatus via the Internet. The claimed management center is distinct from the destination input by the panel. Claim 30 generally recites a related method.

To the contrary, MORI relates to an Internet facsimile apparatus in which a user performs a transmission manipulation, the contents input through the transmission manipulation are analyzed, header information is created for an e-

mail, transmitted image information is created, the transmitted image information is transformed into the MIME format, and the created information is transmitted to an associated mail server. However, MORI does not teach that the Internet facsimile apparatus MORI transmits the e-mail both to a destination input by the user and to a management center which is distinct from the destination input by the user. For example, MORI merely discloses “the main text information created at Step S 105 is transmitted to the associated mail server (Step S 106)” (See MORI at col. 8, lines 10-12). Thus, MORI does not disclose the image communication apparatus which transmits an e-mail to a destination input by the panel and to a management center being distinct from the destination input by the panel, as cited in Applicant’s independent claims 20 and 30.

Further, with respect to the Examiner’s assertion regarding MORI, Applicant submits that this assertion is entirely without support and requests that the Examiner cite at least one reference in support of this assertion (together with a proper motivation to combine it with MORI), if the Examiner chooses to maintain this rejection.

Therefore, it is respectfully submitted that at least the above noted features as recited in Applicant’s independent claims 20 and 30 are not disclosed by MORI. The pending claims are submitted to also be patentable over the Examiner’s proposed reference, since MORI does not disclose the unique combination of features recited in Applicant’s independent claims 20 and 30.

Nevertheless, with respect to the Examiner's rejection of the dependent claims, since corresponding claims 21-22 and 31-32 are dependent from an allowable independent claim, which is allowable for at least the reasons discussed *supra*, these claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record. Accordingly, the Examiner is respectfully requested to withdraw all rejections under 35 U.S.C. § 103 (a).

Applicant also notes that claim 26 and 35 are dependent claims not of independent claims 20 and 30, but of independent claim 24 and 33, respectively. Thus, Applicant respectfully submits that it is not appropriate to reject claims 26 and 35, based on the reference for rejecting claims 20 and 30. Nevertheless, as these claims are respectively dependent from allowable claims 24 and 33, these independent claims being allowable for at least the reasons discussed *supra*, these dependent claims are also allowable.

Further, Applicant notes that that although the status of the present application is after final rejection, the present amendment is appropriate for entry in accordance with 37C.F.R. § 1.116 as it is believed that no new issues are raised thereby, and that Applicant has clearly placed the present application into condition for allowance.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding objection and rejections, and an indication of the allowability of all the claims pending in the present application in due course.

**SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended claims for consideration by the Examiner. With respect to the pending claims, Applicant has eliminated the basis for the rejection. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and with respect to the claimed features argued as deficient in the prior art, should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. Applicant further expressly includes the arguments submitted in Applicant's previous response filed on February 20, 2004. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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